

REMARKS

This amendment is submitted in response to the Office Action mailed on October 1, 2004. Claims 7-8, 10-12, 14-18 and 23-25 are pending in this application. Claims 1-6, 9, 13 and 19-22 have been cancelled previously. In the Office Action, Claims 7-8, 10-12 and 23-25 are rejected under 35 U.S.C. §112, first paragraph; Claims 7-8 and 10-12 are rejected under 35 U.S.C. §112, second paragraph; Claims 7-8, 10-12, 14-18 and 23-25 are rejected under 35 U.S.C. §102; and Claims 7-8, 10-12, 14-18 and 23-25 are rejected under 35 U.S.C. §103. In response, Claim 23 has been amended and Claim 24 has been canceled without prejudice or disclaimer. This amendment does not add new matter. In view of the amendments and/or for the response set forth below, Applicants respectfully submit that the rejections should be withdrawn.

In the Office Action, Claims 7-8, 10-12 and 23-25 are rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. Specifically, the Applicants' specification is said to not provide support for the limitation "ingested principally through the gastrointestinal region of the individual" in Claim 7, limitation "as part of a caffeine containing drink" in Claim 23 and limitation "drink is coffee" in Claim 24.

Claim 23 has been amended, and Claim 24 has been canceled. In view of the amendment to Claim 23, Applicants submit that this claim complies with 35 U.S.C. §112. With respect to Claim 7, Applicants believe that the specification provides sufficient support for "ingested principally through the gastrointestinal region of the individual" in Claim 7, for example, at page 2, lines 11-13. Based on at least these noted reasons, Applicants believe that the claims fully comply with 35 U.S.C. § 112, first paragraph. Accordingly, Applicants respectfully request that the rejection of the claims under 35 U.S.C. § 112, first paragraph, be withdrawn.

In the Office Action, Claims 7-8 and 10-12 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the phrase "providing the stimulant in a form wherein it can be absorbed" in Claim 7 is said to be confusing. Further, the specification is said to not define "the typical amount" in the phrase "the chewing gum including less than the typical amount of stimulant that is swallowed by the individual to achieve the effect" of Claim 7. Applicants believe that these claim terms are clear and definite in scope and meaning as defined in the claims and further supported in the specification.

Applicants believe the phrase “providing the stimulant in a form wherein it can be absorbed” is sufficiently understood by one having ordinary skill in the art to be the form of the stimulant added to the chewing gum so as to be capable of being absorbed through the oral mucosa as described in the specification, for example, on page, 7, lines 20-25. The stimulant form can be, for example, water soluble or water insoluble. See, specification, page 13, lines 30-31 and page 14, lines 1-10. Further, the specification provides that less stimulant can be placed in the chewing gum than is typically orally administered (e.g., swallowed) to an individual to achieve an effect. See, specification, page 8, lines 2-28. Indeed, Applicants conducted an experiment to compare the caffeine delivery effects between chewing gum pieces with 50 mg of caffeine made pursuant to an embodiment of the present invention and chewable No-Doz® tablets with 100 mg of caffeine. See, specification, Experiment No. 2, beginning on page 16. In view of same, one skilled in the art would recognize that the chewing gum as claimed includes an amount of stimulant, such as caffeine, that is less than an amount of the same stimulant as swallowed, such as via oral administration in the form of a typical tablet or capsule. Therefore, Applicants believe that the claimed invention as defined in Claims 7-8 and 10-12 is definite in scope and meaning and thus complies with 35 U.S.C. §112, second paragraph. Accordingly, Applicants respectfully request that this rejection be withdrawn.

In the Office Action, Claims 7-8, 10-12, 14-18 and 23-25 are rejected under 35 U.S.C. §102(e) as anticipated by U.S. Patent No. 6,586,023 to Song et al. (“*Song*”). Applicants respectfully submit that *Song* is not proper prior art.

The current patent application claims the filing date of an earlier non-provisional patent application filed on April 6, 1999. On the other hand, *Song* has an earliest effective prior art date of September 2, 1999. Although the *Song* application is a continuation-in-part application, and the parent application has an earlier filing date, the Patent Office has not demonstrated that the subject matter relied on for the anticipation rejection was not new matter added to the continuation-in-part application. Thus, the earliest effective filing date of the present application antedates *Song* and renders *Song* unavailable for use as prior art under §102(e).

Accordingly, Applicants respectfully request that the anticipation rejections under 35 U.S.C. §102(e) be withdrawn.

In the Office Action, Claims 7-8, 10-12, 14-18 and 23-25 are rejected under 35 U.S.C. §103 as being unpatentable over WO 98/23165 to Gudas et al. ("*Gudas*"). Applicants believe these rejections are improper for at least the reasons set forth below.

For example, the *Gudas* reference is deficient with respect to the stimulant delivery features as claimed. At the outset, the Patent Office even admits that *Gudas* is silent as to the teaching of the saliva content of the stimulant. Further, *Gudas* does not teach or suggest chewing and continuing to chew the chewing gum, thus causing the stimulant to adsorb through the oral cavity as claimed. Indeed, the emphasis of *Gudas* relates to masking the unpleasant taste of caffeine by a coating and not stimulant delivery through the oral mucosa. See, *Gudas*, page 6, lines 33-39. Because the caffeine is coated to mask its bitter taste, *Gudas* avoids or minimizes caffeine being absorbed (i.e. tasted) in the mouth. Thus, *Gudas* effectively teaches away from caffeine being adsorbed through the oral cavity. Based on at least these reasons, one skilled in the art would recognize that *Gudas* fails to render obvious the claimed invention.

Accordingly, Applicants respectfully request that the obviousness rejections with respect to Claims 7-8, 10-12, 14-18 and 23-25 be reconsidered and the rejection be withdrawn.

For the foregoing reasons, Applicants respectfully request reconsideration of the above-identified patent application and earnestly solicit an early allowance of same.

Respectfully submitted,

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